

REMARKS

The disclosure was objected to because the specification claimed priority to application 09/595,835. The specification incorrectly identified the filing date as June 16, 2002. The specification has accordingly been amended to correct the filing date of application 09/595,835 as June 16, 2000.

Claims 1, 4-17, 19-20 and 74 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 6,427,826 to Li. In response, a terminal disclaimer in accordance with 37 CFR 1.321 is filed herewith. This rejection is therefore obviated and withdrawal of the rejection is thus respectfully requested.

Claims 1, 4-17, 19-20, and 74 were rejected under 35 USC 102(e) as being anticipated by Person Hei (US Pat. No. 6,673,753). The Person Hei reference and the present application claim priority to the same patent. That patent is US 6,288,012. The Examiner can find that US 6,288,012 discloses use of a silicone oil and a silicone surfactant in a lubricant. In particular, in column 3 at lines 24-30, the '012 patent teaches that "silicates, silicones, such as silicone surfactants" are examples of synthetic oils effective in lubricating. Again in column 11 of the '012 patent, the table found between lines 42 and 60 lists polydimethylsiloxane as a material used in the Examples. Therefore, the parent of the present application disclosed use of silicone oils and silicone surfactants and the present application is entitled to the priority of that teaching. As such, with respect to the teaching of incorporating silicone oils and silicone surfactants into a lubricant, the Person Hei reference does not have priority predating the present application. The Person Hei reference was not, therefore, a patent granted on an application . . . "before" the invention by the applicant for patent. Additionally, the '012 patent named the exact same inventive entity as the present application. Thus, the subject matter as described in Person Hei, et al. was not invented by "another" in the sense of 35 U.S. C. 102(e). Applicants respectfully request withdrawal of this rejection.

The Examiner rejected claims 1, 4-5, 10-11, and 74 under 35 USC 102(e) as being anticipated by Li (US Pat. No. 6,288,012). The inventors of the present application are Minyu Li,

Keith Darrell Lokkesmoe, and Guang-Jong Jason Wei. Since the inventors of the Li reference are identical to those of the present application, the Li reference, US Patent 6,288,012, does not constitute prior art under 35 USC 102(e) because the reference is not the invention "by another." As such, Applicants respectfully request withdrawal of this rejection.

The above specification amendment and terminal disclaimer are submitted along with the following remarks to be fully responsive to the outstanding Office Action mailed August 6, 2007. It is further submitted that this response is timely filed within the three month shortened statutory period. Reconsideration of all outstanding grounds of objection and rejection and allowance of the subject application are respectfully requested.

CONCLUSION

In light of the foregoing remarks, it is respectfully submitted that the grounds of rejection raised in the pending Office Action have been overcome and that the present case is now in condition for allowance. The prompt issuance of a notice to that effect is solicited.

Respectfully Submitted,
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